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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/863,752

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Peter J. Kuzma

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9127

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11/17/2004

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EXAMINER

LEE, BENJAMIN C

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,752

Applicant(s)

KUZMA ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response To Request For Reconsideration

Claim Status

1. **Claims 1-4** are pending.

Claim Rejections - 35 USC § 103

2. **Claims 1-2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al. (US pat. #5,528,222) in view of Stanfield et al. (US pat. #5,751,221) as stand in the previous Office action.
3. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al. in view of Stanfield et al. and Isaacman et al. (US pat. #5,936,527) as stands in the previous Office action.
4. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al. as stands in the previous Office action.

Response to Arguments

5. Applicant's arguments filed Aug. 9, 2004 have been fully considered but they are not persuasive.

1) Regarding the rejection of claim 1, the RFID transponder of Moskowitz et al. when shown as stand-alone includes adhesive layer 250 disposed on the side of the substrate opposite where the antenna is disposed for attachment to its intended-use environment, so that when shown embedded in the cover (the front of two, i.e. front & back covers) of passport 900 in Fig. 9, inherently involves adhering via the adhesive 250 to the cover layers/material in the embedded condition, thus satisfying the claimed feature of "the transponder assembly being attached to one of the covers by the adhesive". Fig. 9 in combination with col. 6, lines 58-63 clearly indicates

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that the transponder 920 is embedded in the single front cover 910. As stated in the previous Office action, since Stanfield et al. teaches in the same RFID art the known application of RFID devices 120 of unspecified assembly to files 70 by attaching the RFID device to one of the two covers of the file for identification and location tracking of the file according to Fig. 15 and Abstract, in view of the 2 teachings, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the specific RFID assembly such as taught by Moskowitz et al. for identifying a passport and its owner would have worked just as well for application to a file for the purpose of identifying the file and tracking location of the file through said identification such as taught by Stanfield et al., and therefore to use such RFID transponder assembly taught by Moskowitz et al. as a specific transponder assembly and mounting/attachment to implement the RFID device in the Stanfield et al. file system. This combination clearly meets all of the claimed subject matter.

2) Regarding the rejection of claim 2, since Moskowitz et al. teaches attachment of the transponder by embedding the whole transponder in one of the covers (front cover) of an object such as a passport, the combined teachings of Moskowitz et al. and Stanfield et al. (RFID device attached to a file as a specific object) meets the claimed limitation of embedding the transponder including its antenna on one of the file covers.

3) Regarding the rejection of claim 3, the rejection is sound as detailed above and according to the motivation of combination specified in the previous Office rejection of claim 3.

4) Regarding the rejection of claim 4, Moskowitz et al. shows a transponder assembly in stand-alone embodiment as well as when the transponder assembly has been applied (attached or embedded) to its intended use environment. As indicated in the previous Office action,

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Moskowitz et al. discloses that in certain applications such as when the transponder is applied to a postage stamp, the bottom surface of the transponder has a pressure sensitive adhesive to bond the stamp to a package or letter envelope (col. 6, lines 38-52. As such, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use a release backing sheet attached to the adhesive layer, as does conventional stamps having pressure sensitive adhesives, to prevent destroying of the adhesives before it is actually applied to a bonding/labeling surface.

5) In conclusion, Applicant's arguments are not deemed persuasive as all of the arguments have been rebutted above, and the rejection is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

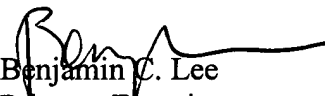
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.